

# Kluwer Patent Blog

## Plant protection in Europe: a seamless fit no more?

Thorsten Bausch (Hoffmann Eitle) · Thursday, November 8th, 2012

EPO practice on patenting plants knows two exclusions that are defined in Art. 53(b) EPC: the exclusion of “plant varieties”, and the exclusion of “essentially biological processes for the production of plants”.

The recent referral G2/12 may change this practice and may lead to the exclusion of plants depending on how they were made. The referring Board questions the patentability of product claims for plants obtained by classical breeding methods, even if the claims are not directed to plant varieties.

The exclusions of Art. 53(b) EPC have been subject to Enlarged Board of Appeal decisions G1/98 and G1/08, respectively. The extent of plant variety exclusion was discussed in G1/98. Based on the legislative motivation to exclude double protection it was held that the exclusion defines “the borderline between patent protection and plant variety protection. The extent of the exclusion for patents is the obverse of the availability of plant variety rights.” (G1/98, reasons 3.10).

This reasoning established a seamless fit between plant variety rights on the one hand, and protection by patents on the other. Subject matter for which plant variety protection is available is excluded from patentability, and vice versa, without a “gap” between these protective rights.

The recent referral by decision [T1242/06](#), with the case number G2/12, may require a readjustment of this concept.

Whilst the referring board recognized the legislator’s intention to “consider plant breeders’ rights and patents as a single comprehensive system, so that the two forms of protection together permitted neither overlapping nor gaps in the protection of eligible subject-matter” (T1242/06, reasons 35), the Board nevertheless questions whether claims to plants that are not directed to a variety may be excluded from patentability. The following questions were referred to the Enlarged Board of Appeal, under case number G2/12:

1. Can the exclusion of essentially biological processes for the production of plants in Article 53(b) EPC have a negative effect on the allowability of a product claim directed to plants or plant material such as a fruit?
2. In particular, is a claim directed to plants or plant material other than a plant variety allowable even if the only method available at the filing date for generating the claimed subject-matter is an essentially biological process for the production of plants disclosed in the patent application?

3. Is it of relevance in the context of questions 1 and 2 that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Article 53(b) EPC?

The opponent has in the meanwhile withdrawn its appeal after the questions were referred to the Enlarged Board of Appeal. Still, the questions of law remain pertinent for patentee's appeal.

The referring decision T1242/06 is, in fact, the second referral in these appeal proceedings. The first referral, leading to G1/08 (jointly dealing with the so called "tomato" and "broccoli" cases), concerned the interpretation of the exclusion of "essentially biological process for the production of plants" (Art. 53(b) EPC). As a noteworthy legal twist, G2/12 concerns the interpretation of the very same legal provision as G1/08, namely the exclusion of "essentially biological process for the production of plants" under Art. 53(b) EPC. Whilst G1/08 dealt with this exclusion in the context of process claims, G2/12 deals with product claims.

This interesting constellation comes about based on the following considerations.

In a first aspect, the referring Board comes to the conclusion that the claimed tomatoes, characterized by the trait of natural dehydration and wrinkling of the skin without microbial spoilage, do not represent a plant variety as excluded by Art. 53(b) EPC.

This touches on the question as to how to define the borderline between "plants" and "plant varieties". In G1/98, transgenic plants characterized by specific recombinant DNA sequences were not considered "a concrete living being or groupings of concrete living beings but an abstract and open definition" (cf. G1/98, reason 3.1, paragraph 10, line 4-5).

In T1242/06, the referring Board also held that it would take a "multitude of characteristics", not just "a single trait" to define a variety, even if the claim relates to a single species (reason 29). A "single trait" would not suffice to define a plant variety if there is no other indication about the genotype of the plant grouping since a plant variety would be defined by the "entire genome and not merely by a particular individual character" (reason 30).

This raises the question of at what stage a "multiplicity of characteristics" turns a generically defined plant into a variety. How many "characteristics" will it take before the EPO considers a claim to be directed to a plant variety? There appears to be a grey zone between an "abstract and open" definition (G1/98) and a "multiplicity of characteristics" (T1242/06), which may require further elucidation by case law.

Having found that the claims are not directed to plant varieties, the Board did not stop there. Rather, it posed the question as to whether granting product protection to plants produced by a classical breeding process that is prohibited from patent protection per se would "frustrate the legislator's intention" and could be excluded for this reason. The Board saw a potential inconsistency between the legislator's decision to exclude processes for producing plants, but allowing the protective scope of a product claim which *inter alia* forbids producing the plants (reason 45).

This raises the question as to why the legislator did not express such an intention in Art. 53 (b) EPC, as foreshadowed in G1/98, reason 3.3.1: "The use of the more specific term "variety" within the same half-sentence of the provision relating to products is supposed to have some meaning. If it was the intention to exclude plants as a group embracing in general varieties as products, the

provision would use the more general term plants as used for the processes.”

Whilst there is agreement that classic plant breeding processes should be excluded from patentability, we learn surprisingly little about the actual “intention” of the legislator behind this exclusion. A full understanding of the intention of the legislator should be of central importance for deciding G2/12. Only an inferred intention could potentially justify giving the exclusion of breeding processes a meaning which goes beyond the text of the law, i.e. extending the process exclusion to products that are produced by the process. Some thoughts on the legislator’s intention are presented in G1/08 (reasons 6.4.2.2 and 6.4.2.3): “Although the explanations given with regard to plants are rather rudimentary, they nevertheless contain some indication that ... the legislator was concerned with excluding from patentability the processes applied by plant breeders in connection with the creation of new plant varieties, for which a special property right was going to be introduced...”. At first glance, this reasoning does not seem forthcoming in supporting a broad reading of the process exclusion, i.e. to extend it to plants as products of the process.

The referring Board mentions the exclusion of human stem cells from patentability (G2/06), based on the prohibition of using human embryos for commercial purposes (Rule 28(c) EPC), as an example of a process exclusion affecting the respective product. However, the Board recognizes a different legislative purpose of this exception as compared to Art. 53 (b) EPC (T1242/06, reasons 50-52). Another fundamental difference to the present case is that Rule 28 EPC merely provides non-limiting examples of the broad exclusion under Art. 53 (a) EPC. There is no such broad exclusion that supersedes the alternatives of Art. 53 (b) EPC.

In summary, the current referral of the Board opens a potential “gap” between plant variety protection and patent protection, which went unnoticed in previous practice. Parties are now faced with the potential scenario of obtaining neither variety protection nor patent protection when the plant is generically defined but obtained by classical breeding methods.

We can already start to see some impact of the referral on national jurisdiction.

The court of The Hague of 31 January 2012 (docket 408315/KG ZA 11-1414) denied a preliminary injunction against an alleged infringer in summary proceedings based on the reasoning that there is a non-negligible likelihood that the product claims to plants are not patentable in light of T1242/06.

This illustrates the need for a quick resolution of this matter by the Enlarged Board of Appeal in order to relieve legal uncertainty on the whole class of protective rights.

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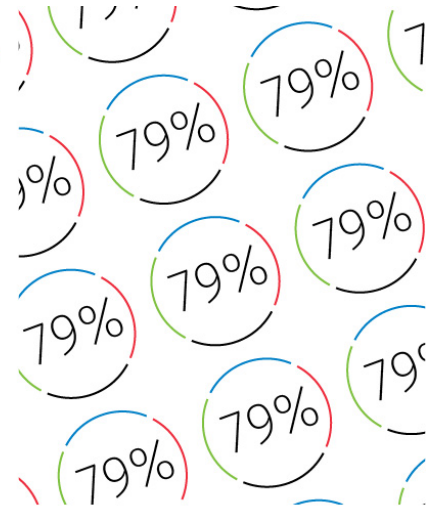
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